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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,689	06/13/2001	Robert D. Fields	10276 (3080-0060)	4306
33432	7590	06/13/2005	EXAMINER	
KILYK & BOWERSOX, P.L.L.C. 53 A EAST LEE STREET WARRENTON, VA 20186			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 06/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/880,689	Applicant(s) FIELDS ET AL.	
	Examiner Janis L. Dote	Art Unit 1756	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attachment, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): see the attachment, paragraph 2.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 2,4-7,9-11,13-20,22-33,35-41 and 44-46.

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

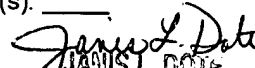
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attachment, paragraph 3.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____


 JANIS L. DOTE
 PRIMARY EXAMINER
 GROUP 1500
 700

Art Unit: 1756

1. The proposed amendments to claims 30, 40, and 46, replacing the 2 minute charge level from "about -20 to about -30 $\mu\text{C/g}$ " to -- -20 to about -30 $\mu\text{C/g}$ - raise new issues, because the proposed charge level limitation was not present in the claims when the final office action was mailed on Feb. 23, 2005.

2. The 35 U.S.C. 103(a) part of the rejections of claims 4, 13, 17, 22, 30, 33, 35, 38, 40, and 41 under 35 U.S.C. 102(e)/103(a) over US 6,692,880 B2 (Fields'880) and of the rejections under 35 U.S.C. 103(a) of claims 25-29 over Fields'880 combined with the other cited references, set forth in the final office action mailed on Feb. 23, 2005, paragraphs 9-13, respectively, have been withdrawn because Fields'880 is not available as prior art under 35 U.S.C. 103(c). Fields'880 was published after the filing date of the instant application, but was filed before the instant application. Applicants' representative has shown that Fields'880 and the instant application were commonly owned by the same entity at the time the invention in the instant application was made. See applicants' response filed on May 25, 2005, page 12, lines 16-19.

Art Unit: 1756

3. The examiner's refusal to enter the amendment filed on May 25, 2005, renders moot applicants' arguments regarding said amendment. For the reasons discussed in the final rejection mailed on Feb. 23, 2005, instant claims 2, 4-7, 9-11, 13-20, 22-33, 35-41, and 44-46 stand rejected.

Furthermore, applicants' arguments that the 2 minute charge levels of $-16.8 \mu\text{C/g}$ in Fields' 880 and of $-15.6 \mu\text{C/g}$ in Fields' 466 do not fall within the range of "about -20 to about -30 $\mu\text{C/g}$ " recited in instant claims 30, 40, and 46 are not persuasive for the reasons of record. As discussed in the final rejection, paragraphs 9 and 17, the term "about" admits variation. Applicants' assertion that the charge level of about $-20 \mu\text{C/g}$ is not within a charge level $-16.8 \mu\text{C/g}$ or $-15.6 \mu\text{C/g}$ is mere attorney argument. There is no objective evidence on the present record showing that charge level of "about $-20 \mu\text{C/g}$ " is patentably distinct from the Fields' 880 charge level of $-16.8 \mu\text{C/g}$ or from the Fields' 440 charge level of $-15.6 \mu\text{C/g}$.

Applicants' traversal based on the attempted limitation of Fitzgerald to prima facie anticipation or obviousness when the composition is expressly disclosed, but certain properties are not disclosed, is not persuasive. The USPTO is not in a position to conduct tests of prior art disclosures. When the prior art composition is disclosed to have all of the properties

Art Unit: 1756

required by a claimed composition, and particularly when, as here, the instant application teaches that certain of the properties are due to the presence of a particular material, i.e., colloidal silica or silica particles, the question arises whether the disclosed composition of the prior art is in fact an embodiment of the claimed composition. As discussed in the final rejection, paragraphs 10 and 18, both Fields'880 and Fields'446 each teach toner particles that meet the charge properties recited in the instant claims. Neither reference explicitly discloses that its toner particles comprise the silica particles recited in the instant claims. However, neither does the instant specification explicitly identify the source of the colloidal silica or silica in the toner particles exemplified in the inventive examples of the instant specification. See the instant specification, Table 1 at page 22. The toner binder resins used in the toner particles of Fields'880 and in the toner particles of Fields'446 are cross-linked styrene-acrylate resins obtained from Eastman Kodak. Furthermore, the Fields'880 toner binder resin is associated with product SB77XL, which is also used as the toner binder resin in the examples of the instant specification. When, as here, the inventive examples in the instant specification, which are said to have all of the properties required of the claimed

Art Unit: 1756

composition, are silent as to the origin of the particular colloidal silica or silica, but share a common component with at least one of the references, i.e., SB77XL, an Eastman Kodak resin, and the other reference, unnamed Eastman Kodak binder resin, the presumption becomes strong that the toner binder resin is the source of the "missing component," i.e., the colloidal silica or silica. Surely, the burden on applicants to identify the source of the colloidal silica or silica in their inventive examples is trivial. Moreover, because the toner binder resins in the references are Eastman Kodak materials and because the references also share common inventors with the instant application, the burden on applicants to verify the presence (or absence) of colloidal silica or silica in the toner binder resins of the references is equally trivial. Of course even, if the toner binder resins were not obtained from the same source, it would be appropriate to shift the burden to applicants to disclose the source of colloidal silica or silica in their inventive examples and to distinguish the prior art toner particles from the claimed toner particles.